

asserted that the inventions are distinct because the claimed products could be made by other materially different processes.

Applicants respectfully traverse this requirement for restriction.

Policy for imposing restriction requirements has been established by M.P.E.P. § 803: "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." For the present application, to adequately examine any of these aspects of the invention, it certainly will be necessary to search all of them, so the burden of examining them together will not be serious.

Only a single chemical compound is recited in all of the claims of this application, that compound being esomeprazole magnesium trihydrate, and all of the claims are further restricted to a particular crystalline form of the compound, form II. In addition, the claimed processes (independent claims 19 and 31) have related steps. Searching and examining all of the claims simply cannot be a serious burden.

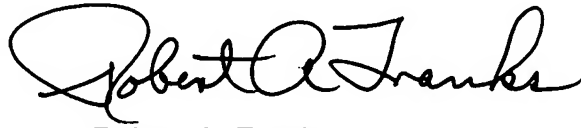
Further, there has not been a proper determination that the "inventions" are distinct. As explained in M.P.E.P. § 802.01, one element of the definition of "distinct" is that the related subjects "are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art)." The record does not reflect any consideration of this point, rendering the restriction requirement deficient and improper.

With regard to the *Weber* and *Hengehold* decisions cited in the Office Action, applicants point out that the decisions do not relate to the substance of claim restriction, but only to the judicial reviewability of restriction requirements. These decisions therefore are not relevant to the present issues.

Applicants respectfully urge withdrawal of the restriction requirement and examination of all of the claims, as presently amended. However, if the requirement is maintained, applicants provisionally elect the claims of Group I (being claims 1-18 and 30-36) for immediate examination.

If any minor matters remain to be resolved in connection with this submission, please contact the undersigned to arrange a telephonic or personal interview.

Respectfully submitted,

A handwritten signature in black ink, reading "Robert A. Franks". The signature is fluid and cursive, with the first name "Robert" being more prominent and the last name "Franks" following in a similar style.

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